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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER
WALLERSON, M

ART UNIT	PAPER NUMBER
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2722

DATE MAILED: 05/22/00

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/579,733

Applicant(s)
Hiroshi Nobuta et al

Examiner
Mark Wallerson

Group Art Unit
2722



☒ Responsive to communication(s) filed on Mar 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24, 26, 27, 29, and 57-59 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24, 26, 27, 29, and 57-59 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 3/20/2000.
2. This application has been reconsidered. Claims 24, 26, 27, 29, and 57-59 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 24, 27, 57, and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Kita et. al. (hereinafter referred to as Kita) (U. S. 5,021,892).

With respect to claims 24 and 27, Kita discloses an image processing device (1) comprising a scanner (60) for inputting an image signal (column 5, lines 16-47); a control unit (which reads on 50, 51, 52, 54, 56, and buses (DB, AB, and CB)) including a control circuit (50) for controlling the device (column 4, lines 46-54) and performing necessary image processing on the image signal input from the scanner to provide a first processed image signal (column 5, lines 33-37); a bidirectional interface (5) for transmitting the image signal input by the scanner (60)

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under control of the control unit (50) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); an output circuit (66 and 67) for outputting the first and second signals to a printer (3), wherein the device has a plurality of modes (column 6, line 50 to column 7, line 25), the image signal from the scanner being transmitted in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), bidirectional interface (5), the external computer (8), the bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and the output unit (66 and 67) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)) and the output circuit (66 and 67) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner).

With respect to claim 57, Kita discloses that the output means (3) includes a bidirectional interface (66).

With respect to claim 59, Kita discloses a density adjusting feature (figure 2, part 25).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kochis et. al. (hereinafter referred to as Kochis) (U. S. 5,218,458).

With respect to claims 26 and 29, Kita differs from claims 26 and 29 in that he does not clearly disclose that the computer has a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. Kochis discloses a system that transmits a data file between two computer systems via a telephone line (110, figure 1), utilizing PC fax cards (which reads on a modem) (column 2, lines 53-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the computer would have a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kochis in order to be able to transfer files between computer systems as taught by Kochis in column 1, lines 6-7.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kenmochi et. al. (hereinafter referred to as Kenmochi) (U. S. 5,900,947).

With respect to claim 58, Kita differs from claim 58 in that he does not clearly disclose that the scanner generates a color image signal. Kenmochi discloses a communications apparatus wherein a color reading unit may be utilized (column 11, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the scanner would generate a color image signal. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kenmochi in order to output color data to the personal computer as disclosed by Kenmochi in column 12, lines 1-3.

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Response to Arguments

9. Applicant's arguments filed 3/20/2000 have been fully considered but they are not persuasive.

Applicant's argument on lines 8-12 on page 8 of the amendment filed 3/20/2000 is confusing. Applicant states that "in **the second copying mode**, the image signal from the scanner is outputted to the printer **without** involvement of the external computer. Thus, the first **and second copying modes** allow for special editing to be performed by an external computer". If there is no involvement by the external computer in the second copying mode, it is unclear to the Examiner how editing of the image signal can be performed by the external computer during the second copying mode.

Applicant submits that nothing has been found in Kita that teaches or suggests an image processing device that "has a plurality of modes including first and second copying modes, the image signal from the scanner being transmitted in order of control unit, bidirectional interface, the external computer, the bidirectional interface, the control unit, and the output circuit in the first copying mode so as to perform copying based on the second processed image signal, and the image signal from the scanner being transmitted in order of the control unit and the output unit in the second mode so as to perform copying on the first processed image signal". The Examiner respectfully disagrees.

Kita discloses an image processing device (1), wherein the device has a plurality of modes (column 6, line 50 to column 7, line 25) including a first copying mode (scanner to computer to

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printer) (column 5, lines 65-68) and a second copying mode (scanner to printer) (column 6, lines 51-55), the image signal from the scanner being transmitted in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), bidirectional interface (5), the external computer (8), the bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and the output unit (66 and 67) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)) and the output circuit (66 and 67) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner).

Conclusion

10. All claims are rejected.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN

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THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

(703) 308-9589 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PATENT EXAMINER



Mark Wallerson

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A handwritten signature in black ink, appearing to read 'Ed Coles', with a stylized flourish at the end.

EDWARD COLES, SR.
SUPERVISORY PATENT EXAMINER
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